DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 3/14/2008 and 5/19/2008 have been entered.

2. All outstanding claim objections are withdrawn in light of applicant's amendment filed on 3/14/2008.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Request for Interview

4. In the supplemental response filed on 5/19/2008, applicant requested a telephonic interview. This request is being denied because examiner already granted a telephonic interview after filing of the RCE on 5/15/2008.

Claim Rejections - 35 USC § 112

5. Claims 1-8, 10-22, 30, 31, 35, 39-59, 61, 62, 67-70, 121, 122, 132, 133, 139, 141, 143-145, 147-151, 160, 161, 164-168, 184, 186, 187, and 191 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1, 35, 56, 67, 70, 121, and 164, the phrase "curable in air" fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "curable in air" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for a composition curable by "air drying" on page 25, paragraph 0071 of the specification, there is no support for the broader phrase "curable in air." Specifically, "curable in air" suggests curing that occurs in the presence of air, i.e., curing under conditions that does not include vacuum.

With respect to claims 7-8, 10-22, 30, 31, 39-55, 57-59, 61, 62, 68, 69, 132, 133, 139, 141, 143-145, 147-151, 160, 161, 165-168, 184, 186, 187, and 191, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 102

6. Claims 1, 7, 10, 11, 13, 14, 17, 19, 56-58, 141, 143-145, and 164-166 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al (JP 05-117589).

The discussion with respect to Takeuchi et al in paragraph 9 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Takeuchi et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

Claim Rejections - 35 USC § 103

7. Claims 2, 3, 67, 68, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al (JP 05-117589, machine translation).

The discussion with respect to Takeuchi et al in paragraph 10 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Takeuchi et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

8. Claims 1-8, 10-20, 30, 31, 56-59, 61, 62, 67-69, 139, 141, 143-145, 147-150, 164-168, and 184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780).

The discussion with respect to Shoji et al in paragraph 11 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Shoji et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

9. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Oakes (US 4,370,256).

The discussion with respect to Shoji et al and Oakes in paragraph 12 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Shoji et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

10. Claims 35, 39-52, 54, 55, 70, 121, 122, 132, 133, 151, 160, 161, 186, and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368).

The discussion with respect to Shoji et al and Reuter et al in paragraph 9 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Shoji et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

11. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Tucker (US 3,837,894).

The discussion with respect to Shoji et al, Reuter et al, and Tucker in paragraph 10 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Shoji et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

12. Claims 191 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Koefod (US 5,531,931).

The discussion with respect to Shoji et al, Reuter et al, and Koefod in paragraph 11 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "curable in air," Shoji et al does not teach that composition is cured in a vacuum and is therefore "curable in air."

Double Patenting

Two (2) obviousness-type double patenting rejections are set forth below.

Double Patenting, I

13. Claims 1-7, 15, 17, 35, 42-45, 70, and 151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 10/758,973 (published as US 2004/0186201, cited on IDS filed 3/16/2005).

US appl. '973 claims a coating composition comprising one or more rare earth oxide compounds, a binder, and one or more neutral to slightly acidic generating extenders. While US appl. '973 claims, in addition to the presently claimed ingredients, a corrosion-inhibiting carbon pigment,

the scope of the instant claims clearly encompass the cited claims of US appl. '973 and thus is rendered obvious over US appl. '973. Note page 32, paragraph 102 of the specification of US appl. '973 which states that the coating is cured in air. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Applicant's statement on page 18 of the amendment filed 4/19/2007 regarding the provisional obviousness-type double patenting rejections is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, II

15. Claims 1, 13, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 11/036,416 (published as US 2006/0063872). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '416 claims a corrosion-inhibiting coating composition comprising a fluorinated binder and an effective amount of corrosion-inhibiting compound that praseodymium oxide, wherein the effective amount reads on the presently claimed amount because an effective amount is required to impart corrosion-inhibiting effects like required by the present claims. Note page 24, line 19 of the specification of US appl. '416 which states that the coating is cured in air. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1, 13, and 14 are directed to an invention not patentably distinct from claim 13 of commonly assigned copending Application No. 11/036,416 (published as US 2006/0063872). Specifically, see the discussion set forth in paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/036,416 (published as US 2006/0063872), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C.

103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

17. Applicant's arguments filed 5/19/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that neither Takeuchi et al nor Shoji et al discloses a composition that is curable in air.

In response, when interpreted in the broadest light, the phrase "curable in air" suggests that curing is capable without the use of a vacuum. As neither Takeguchi et al nor Shoji et al requires a vacuum during curing, these references read on the presently claimed "curable in air." Furthermore, it is noted that Shoji et al does not in fact teach heating of the coating composition when it contains a resin in col. 11, lines 19-33. Note that the resin can be epoxy resin (col. 13, line 29), wherein epoxy resins are commonly known to be curable in air.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/4/2008
vr

/Vickey Ronesi/
Examiner, Art Unit 1796